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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,209	07/18/2000	Michael K. Eneboe	K35A0624	8822

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EXAMINER

MOORTHY, ARAVIND K

ART UNIT PAPER NUMBER

2131

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,209

Applicant(s)

ENEBOE, MICHAEL K.

Examiner

Aravind K. Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the amendment filed on 24 February 2005.
2. Claims 1-19 are pending in the application.
3. Claims 1-19 have been rejected.

Response to Arguments

4. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

5. Claims 1-4 and 11 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5 and 11 of copending Application No. 09/618,7654. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious for a disk drive to have executable code.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Li et al U.S. Patent No. 6,119,162.

As to claim 11, Li et al discloses a display generator [column 4, lines 34-39]. Li et al suggests a computing subsystem. Li et al suggests a disk drive connectable to the computing subsystem [column 4, lines 40-60]. Li et al suggests that the disk drive comprises a network address and a server-contacting program [column 4 line 61 to column 5 line 11]. Li et al suggests a disk controller circuit in the disk drive that, upon the occurrence of a selected condition, determines to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system [column 5, lines 12-37]. Li et al discloses that execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server [column 7 line 60 to column 8 line 13].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 in view of Lee et al U.S. Patent No. 6,609,127 B1.

As to claim 1, Li et al selecting a network address for the content delivery server; selecting a server-contacting program [column 4 line 61 to column 5 line 11]. Li et al suggests storing the network address and the server-contacting program in the disk drive. Li et al suggests that the execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server [column 7 line 60 to column 8 line 13].

Li et al does not teach sending user information to the content delivery server while the personal computer system is connected to the content delivery server. Li et al does not teach receiving content from the content delivery server. Li et al does not teach displaying the content on the display device. Li et al does not teach installing firmware in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system.

Lee et al et al teaches sending user information to the content delivery server while the personal computer system is connected to the content delivery server [column 6, lines 35-64]. Lee et al et al teaches receiving content from the content delivery server [column 6, lines 35-64]. Lee et al et al teaches displaying the content on the display device [column 6, lines 35-64]. Lee teaches installing firmware in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system [column 4, lines 13-22].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that user information would have been sent to the content delivery server while the personal computer system was connected to the content delivery server. The personal computer would have received content from the content delivery server and would have been displayed on a display device. Firmware would have been installed on the disk drive to initiate execution of the server-contacting program after the disk drive was connected to the computing subsystem in the personal computer system.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Lee et al et al because firmware stays intact even in the absence of electrical power and it falls between software and hardware in terms of ease of modification.

As to claim 3, Li et al teaches that the firmware comprises a disk controller circuit that automatically initiates execution of the server-contacting program when the disk drive is connected to the computing subsystem in the personal computer system [column 5, lines 27-38].

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 and Lee et al U.S. Patent No. 6,609,127 B1 as applied to claim 1 above, and further in view of Frank, Jr. et al U.S. Patent No. 6,546,489 B1.

As to claim 2, the combination of Li et al and Lee et al does not teach that the disk drive includes a protected area. The combination of Li et al and Lee et al does not teach that the network address and the server-contacting program are stored in the protected area.

Frank, Jr. et al teaches storing data in the disk drive within a protected area [column 7, lines 39-60].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al so that the network address and the server-contacting program would have been stored in the protected area of the disk drive.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al because information stored in the protected area cannot be intercepted by a third party.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 and Lee et al U.S. Patent No. 6,609,127 B1 as applied to claim 1 above, and further in view of Fite et al U.S. Patent No. 5,875,349.

As to claim 4, the combination of Li et al and Lee et al does not teach that the disk controller circuit delays initiating execution of the server-contacting program until a predetermined period has lapsed.

Fite et al teaches a disk controller circuit that delays initiating execution of the server-contacting program until a predetermined period has lapsed [column 4, lines 26-33].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al so that a disk controller would have delayed initiating execution of the server-contacting program until a predetermined period has lapsed.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al by the teaching

of Fite et al because it allow time for the connector to go from partial engagement to full engagement [column 1, lines 56-65].

10. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 and Lee et al U.S. Patent No. 6,609,127 B1 as applied to claim 1 above, and further in view of Mulholland et al U.S. Patent No. 5,875,349.

As to claims 5 and 6, the combination of Li et al and Lee et al does not teach that the firmware delays initiating execution of the server-contacting program until the firmware determines that a selected number of monitored events exceed a threshold. The combination of Li et al and Lee et al does not teach that the monitored events includes the number of boot-ups in the computing subsystem.

Mulholland et al teaches monitoring the number of boot-ups in the computing subsystem [column 2 line 58 to column 3 line 4]. Mulholland et al teaches that the firmware delays initiating execution of the server-contacting program until the firmware determines that a selected number of monitored events exceed a threshold [column 2, lines 25-48].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al so that the number of boot-ups in the computing subsystem was monitored and that the firmware delayed initiating execution of the server-contacting program until the firmware determined that a selected number of monitored events exceed a threshold.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Mulholland et al because it

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allows a computer seller to check how many times a computer system has been used in the case of resale of the computer system [column 1, lines 14-25].

11. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 and Lee et al U.S. Patent No. 6,609,127 B1 as applied to claim 1 above, and further in view of Abgrall U.S. Patent No. 6,373,498 B1.

As to claims 7-10, the combination of Li et al and Lee et al does not teach that the personal computer system receives content data from the content delivery server and subsequently displays the content during a boot sequence. The combination of Li et al and Lee et al does not teach that the content of the displayed content data is periodically changed. The combination of Li et al and Lee et al does not teach that the content data is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data. The combination of Li et al and Lee et al does not teach that the personal computer system receives content from the content delivery server and subsequently displays the content during a boot sequence.

Abgrall teaches a personal computer system receives content data from the content delivery server and subsequently displays the content during a boot sequence [column 8, lines 26-46]. Abgrall teaches that the displayed content data is periodically changed. Abgrall teaches that the content data is advertisement data [column 3 line 56 to column 4 line 31].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al so that advertisements that periodically changed was displayed at boot up.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the combination of Li et al and Lee et al by the teaching of Abgrall because the time to boot up and shut down is sufficiently long for the system to display more informative images, it is desirable to be able to display images other than the standard logos of the operating system [column 1, lines 20-23].

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 as applied to claim 11 above, and further in view of Darago et al U.S. Patent No. 6,170,014 B1.

As to claim 12, Li et al does not teach that the computing subsystem is configured to send user information to the content delivery server while the personal computer system is connected to the content delivery server. Li et al does not teach receiving content from the content delivery server. Li et al does not teach that the display device displays the content during a selected time interval.

Darago et al teaches that the computing subsystem is configured to send user information to the content delivery server while the personal computer system is connected to the content delivery server [column 8, lines 38-52]. Darago et al teaches receiving content from the content delivery server [column 13, lines 15-67]. Darago et al teaches that the display device displays the content during a selected time interval [column 14, lines 14-34].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that subsystem would have sent the user information to the content server while connected to the server and received content from the delivery server. The content would have been displayed for only a selected time interval.

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Darago et al because with a user ID and a password security is enhanced at the content server [column 10, lines 50-61].

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 as applied to claim 11 above, and further in view of Cornaby et al U.S. Patent No. 5,875,349.

As to claim 13, Li et al does not teach that the firmware resides in a disk controller circuit.

Cornaby et al teaches that the firmware resides in a disk controller circuit.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that the firmware resides in a disk controller circuit.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Cornaby et al because only one translation needs to be performed between the operating system and the disk drive. By eliminating this additional translation performed by the disk drive firmware of the prior art system and reducing the translations to a single translation, the approach of the invention speeds up the overall process of handling a read/write request from the operating system and the disk drive and improves the performance of the overall system [column 21 line 65 to column 22 line 22].

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 as applied to claim 11 above, and further in view of Fite et al U.S. Patent No. 5,875,349.

As to claim 14, Li et al does not teach that the disk controller circuit delays initiating execution of the server-contacting program until a predetermined period has lapsed.

Fite et al teaches a disk controller circuit that delays initiating execution of the server-contacting program until a predetermined period has lapsed [column 4, lines 26-33].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that a disk controller would have delayed initiating execution of the server-contacting program until a predetermined period has lapsed.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Fite et al because it allow time for the connector to go from partial engagement to full engagement [column 1, lines 56-65].

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 as applied to claim 11 above, and further in view of Burgess et al U.S. Patent No. 5,696,701.

Li et al does not teach that the firmware delays initiating execution of the server-contacting program until the firmware determines that a selected number of monitored events exceeds a threshold.

Burgess et al teaches firmware that delays initiating execution of the server-contacting program until the firmware determines that a selected number of monitored events exceeds a threshold [column 4, lines 26-36].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that the firmware would have delayed the initiating execution of the server-contacting program until the firmware determined that a selected number of monitored events exceeded a threshold.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Burgess et al because it allows simultaneous performance monitoring of a number of computers, typically server computers, connected to a computer network [column 2, lines 39-57].

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 as applied to claim 11 above, and further in view of Mulholland et al U.S. Patent No. 5,875,349.

As to claim 16, Li et al does not teach that the monitored events includes the number of boot-ups in the computing subsystem.

Mulholland et al teaches monitoring the number of boot-ups in the computing subsystem [column 2 line 58 to column 3 line 4].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that the number of boot-ups in the computing subsystem was monitored.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Mulholland et al because it allows a computer seller to check how many times a computer system has been used in the case of resale of the computer system [column 1, lines 14-25].

17. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al U.S. Patent No. 6,119,162 as applied to claim 11 above, and further in view of Abgrall U.S. Patent No. 6,373,498 B1.

As to claims 17-19, Li et al does not teach that the personal computer system receives content data from the content delivery server and subsequently displays the content during a boot sequence. Li et al does not teach that the content of the displayed content data is periodically changed. Li et al does not teach that the content data is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data.

Abgrall teaches a personal computer system receives content data from the content delivery server and subsequently displays the content during a boot sequence [column 8, lines 26-46]. Abgrall teaches that the displayed content data is periodically changed. Abgrall teaches that the content data is advertisement data [column 3 line 56 to column 4 line 31].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al so that advertisements that periodically changed was displayed at boot up.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Li et al by the teaching of Abgrall because the time to

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boot up and shut down is sufficiently long for the system to display more informative images, it is desirable to be able to display images other than the standard logos of the operating system [column 1, lines 20-23].


Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
May 12, 2005


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